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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,252	02/09/2004	Mark Alan Etter	54525.000105	7155

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EXAMINER
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WEEKS, GLORIA R

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/773,252

Applicant(s)

ETTER ET AL.

Examiner

Gloria R. Weeks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-21, 24-32 and 35 is/are rejected.
- 7) ☒ Claim(s) 9, 22, 23, 33 and 34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Meurer et al. (USPN 5,810,232).

In reference to claims 1 and 5-7, Meurer et al. discloses a hand-held power tool comprising: a housing (100); at least a first attaching means (16) for selectively detachably mounting a clip (10) to the housing (100) and a second attaching means (20) for selectively detachably mounting a clip (10) to the housing (100); and a single, rigid clip (10) selectively detachably mounted to the housing (100) via either the first attaching means (16) or the second attaching means (20), and a threaded fastener (102), the clip (10) capable of capturing the accommodating surface for suspending the hand-held power tool from the accommodating surface (figure 4); wherein the clip is selectively detachably mountable by a user to the housing, at a first position through the use of the first attaching means and without the use of the second attaching means, and the clip is selectively detachably mountable by a user to the housing at a second position, symmetrically opposite the first position, through the use of the second attaching means (20), and without the use of the first attaching means (column 3 line 57-column 4 line 2).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greig (US Des. 345,465) in view of Shaw (US 2002/0179659).

With respect to claims 1-5, Greig discloses a hand-held power tool comprising: a housing; at least a first attaching means (threaded fasteners; figure 5) for selectively detachably mounting a single rigid clip to the housing and a second attaching means for selectively detachably mounting the clip to the housing; the clip capable of capturing the accommodating surface for suspending the hand-held power tool from the accommodating surface; wherein the first attaching means and the second attaching means comprise, a bore formed in the clip; a bore formed in the housing; a threaded fastener passing through the bore in the clip and received in the bore formed in the housing.

The bores in the housing of Greig pass completely through the housing, therefore, providing capability to position the clip on either side of the housing. Shaw teaches that it is known to position an attaching bore (40) on the side of a hand held device housing, without the bore passing completely through the housing. Meurer et al. teaches, at column 3 lines 64-66, that the positioning of a clip on either side of a tool housing site position on the housing, allows for accommodation of a left-handed operator as well as a right-handed operator. It would have been obvious to one having ordinary skill in the art at the time of the invention to replace the through

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bores on either side of Greig with the non-through bores of Shaw, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same function as before, involves routine skill in the art. Thus, the modified bores of Greigh would allow for selectively detachably mounting of the clip to the housing, at a first position through the use of the first attaching means and without the use of the second attaching means, as well as, selectively detachably mounting of the clip to the housing at a second position, symmetrically opposite the first position, through the use of the second attaching means and without the use of the first attaching means.

5. Claims 2, 8, and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meurer et al. (USPN 5,810,232) in view of Hayasaka (USPN 4,956,895).

Regarding claims 2, Meurer et al. discloses a hand held power tool, comprising: a housing (100) with a first and second attaching means for affixing a clip (10) to the housing (100) wherein the first and second attaching means comprises: a bore (16, 20) formed in the clip (10); a bore formed in the housing (100); and a fastener (102) passing through the bore in the clip (10) and the housing (100). Meurer et al. does not disclose an indexing projection and an indexing projection recess. Hayasaka teaches a housing (50) and a detachable clip (30), wherein an indexing projection 36) extending from the clip (30) is received in an indexing projection recess (54) of the housing (50). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the housing and clip of Meurer et al. to include the indexing projection and indexing projection recess of Hayasaka, for the purpose of properly positioning the clip on the housing.

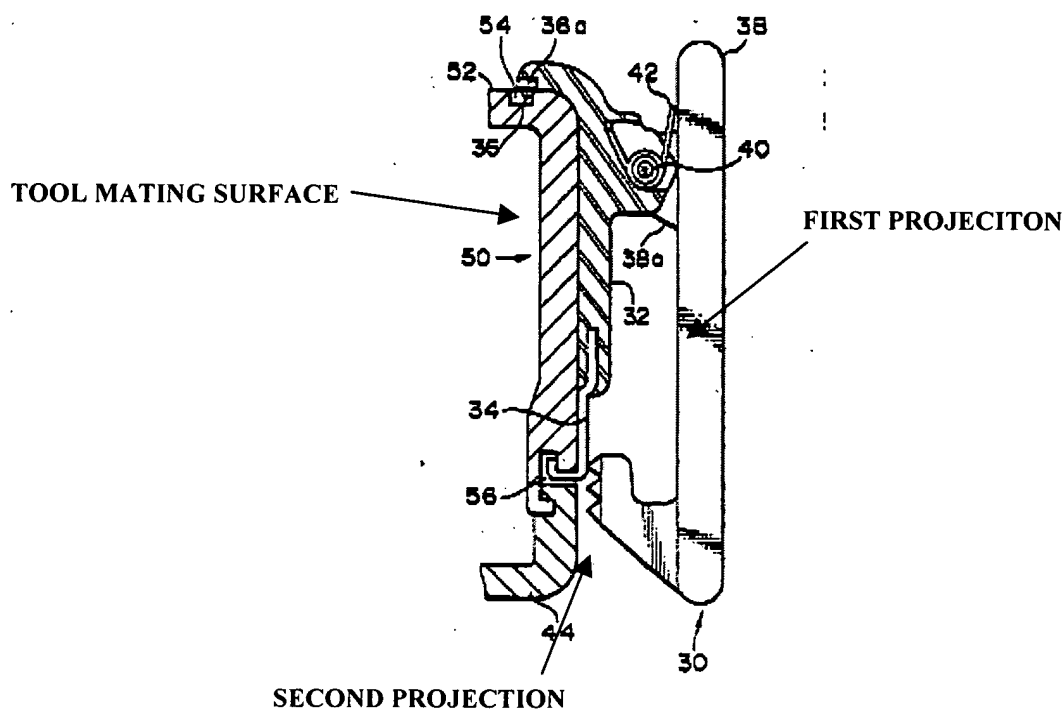


Figure A

In reference to claims 10-12, Meurer et al. discloses a hand-held power tool comprising: a housing (100) having a fastener receiving recess (102); a clip (10) detachably mounted to the housing (100) through attachment of a threaded clip fastener (threaded connecting portion of air hose at 102) to the fastener receiving recess (102), the clip fastener being selectively detachable and reattachable by a user to the fastener receiving recess (102). Meurer et al. does not disclose an indexing projection and an indexing projection recess. Hayasaka teaches a housing (50) and a detachable clip (30), wherein an indexing projection 36) extending from the clip (30) is received in an indexing projection recess (54) of the housing (50). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the housing and clip of Meurer et al. to include the indexing projection and indexing projection recess of Hayasaka, for the purpose of properly positioning the clip on the housing.

Regarding claim 13, Maurer et al. discloses a hand held power tool having a clip (10), wherein the clip (10) comprises: a tool mating surface (opposite 18); a first projection (14) extending outwardly from the tool mating surface at a first end, but does not disclose a second projection extending from a second end of the first projection. Hayasaka teaches a hand held device (50) having a clip (30), wherein the clip comprises: a tool mating surface (32); a first projection (38) extending outwardly from the tool mating surface at a first end, and a second projection extending from a second end of the first projection. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the clip of Meurer et al. to include the second projection of Hayasaka for the purpose of providing a gripping engagement

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or to enclose the receiving space created by the tool mating surface and the first projection, thereby securing the hand held device to a surface.

6. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meurer et al. (USPN 5,810,232) in view of Hayasaka (USPN 4,956,895) as applied to claim 2 above, and further in view of Shaw (US 2002/0179659).

With respect to claims 3 and 4, Meurer et al. discloses a hand held power tool having a housing (100) and a detachable clip (10) mounted to a rear portion of the housing (100) via a bore in the housing (102), a bore (16, 20) in the clip (10) and a threaded fastener, the clip capable of being mounted to extend along a left side or a right side of the housing (column 3 line 58-column 4 line 2). Meurer et al. does not disclose the bore in the housing, through which the clip is mounted to the housing, as being positioned along a side portion of the housing. Shaw teaches that it is known to position an attaching bore (40 on the side of a hand held device housing, for the purpose of securing a detachable clip (10) to the hand held device, which deemed to be a known equivalent structure in the art. Therefore, because these two elements were art recognized equivalents at the time of the invention was made, one of ordinary skill in the art would have found it obvious to substitute the side attaching bore and clip for the rear attaching bore and clip.

It would have been further obvious, at the time of the invention, to modify the hand held power tool housing of Meurer et al. to include an additional attaching bore in a symmetrically opposite position on the housing, since Meurer et al. states at column 3 lines 64-66 that such a modification would allow for accommodation of a left-handed operator as well as a right-handed operator.



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7. Claims 14-19 and 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al. (USPN 5,372,206) in view of Greig (USPN Des. 345,465) and Meurer et al. (USPN 5,810,232).

Regarding claims 14-19, Sasaki et al. discloses a drill comprising: a housing (1) with a barrel portion and a pistol grip portion, the barrel portion at least partially enclosing a rotary motor (2), the pistol grip portion having a switch (3) which controls the rotary motor (2); the housing (1) having a central axis defined by a plane that approximately divides in half the barrel portion of the housing (1) and the pistol grip portion of the housing (1) with a first side of the housing (1) on one side of the central axis and a second side of the housing (1) on the other opposite side of the central axis; a chuck (19); and a clip (upper portion of housing; figure 1) capable of suspending the drill/driver from a surface. Sasaki et al. does not disclose the clip as being selectively detachably, nor does Sasaki et al. disclose mounting the clip in selective positions.

Greig teaches that it is known to mount a detachable clip to a side of housing of a drill/driver. It would have been obvious to one having ordinary skill in the art at the time of the invention to mount a detachable clip to the housing of Sasaki et al., as taught by Greig, for the purpose of interchanging the clip on alternate sides of the drill/driver housing, or for simply having the option of having the clip on the housing or not.

Greig illustrates a drill/driver having a housing with attaching bores on both sides of the housing, through which a clip is capable of being detachably mounted. Although Greig does not illustrate positioning the clip in first and second positions on the drill/driver housing, Meurer et al. teaches that it is known to position a detachable clip along symmetrically opposite sides of a

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drill/driver housing. It would have been obvious to one having ordinary skill in the art the time of the invention to further modify the housing of Sasaki et al. to mount the detachable clip in a first position along a first side of the drill/driver housing, or in a second position along a second side of the drill/driver housing, since Meurer et al. states in column 3 lines 58-66 that such a modification allows for accommodation of a left-handed operator as well as a right-handed operator.

With respect to claims 26-30, Sasaki et al. discloses a drill/driver comprising: a housing (1) with a barrel portion and a pistol grip portion, the barrel portion at least partially enclosing a rotary motor (2), the pistol grip portion having a switch (3) which controls the rotary motor (2); the housing (1) having a central axis defined by a plane that approximately divides in half the barrel portion of the housing (1) and the pistol grip portion of the housing (1) with a first side of the housing (1) on one side of the central axis and a second side of the housing (1) on the other opposite side of the central axis; a chuck (19); and a means (upper portion of housing; figure 1) capable of suspending the drill/driver from a surface. Sasaki et al. does not disclose the clip as being selectively detachably, nor does Sasaki et al. disclose mounting the clip in selective positions.

Greig teaches that it is known to mount a detachable holding means to a side of a housing of a drill/driver. It would have been obvious to one having ordinary skill in the art at the time of the invention to mount a detachable holding means to the housing of Sasaki et al., as taught by Greig, for the purpose of interchanging the holding means on alternate sides of the drill/driver housing, or for simply having the option of having or not having the holding means on the housing.

Greig illustrates a drill/driver having a housing with attaching bores on both sides of the housing, through which a holding means capable of being detachably mounted. Although Greig does not illustrate positioning the a holding means in first and second positions on the drill/driver housing, Meurer et al. teaches that it is known to position a detachable a holding means along symmetrically opposite sides of a drill/driver housing. It would have been obvious to one having ordinary skill in the art the time of the invention to further modify the housing of Sasaki et al. to mount the a holding means in a first position along a first side of the drill/driver housing, or in a second position along a second side of the drill/driver housing, since Meurer et al. states in column 3 lines 58-66 that such a modification allows for accommodation of a left-handed operator as well as a right-handed operator.

8. Claims 20, 21, 24, 25, 31, 32 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al. (USPN 5,372,206) in view of Greig (USPN Des. 345,465) and Meurer et al. (USPN 5,810,232) as applied to claims 19 and 30 above, and further in view of Hayasaka (USPN 4,956,895).

Regarding respect to claims 20, 21 and 24, the modified drill/driver of Sasaki et al. in view of Grieg discloses a drill/driver having a housing and a single, rigid clip detachably mounted to the housing, wherein the clip is mounted to the housing via: a bore in the clip, a first bore formed in the first side of the housing, and a second bore formed in the second side of the housing; wherein a fastener passes through the bore in the clip and the first bore in the housing, in the first position, and wherein the fastener passes through the bore in the clip and the second bore in the housing, in the second position. Sasaki et al. in view of Grieg does not disclose an indexing projection and an indexing projection recess. Hayasaka teaches a housing (50) and a

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detachable clip (30), wherein an indexing projection 36) extending from the clip (30) is received in an indexing projection recess (54) of the housing (50). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the housing and clip of Meurer et al. to include the indexing projection and indexing projection recess of Hayasaka, for the purpose of properly positioning the clip on the housing.

In reference to claim 25, Sasaki et al. disclose a drill/driver housing and clip, but does disclose the clip of having a first projection and a second projection. Hayasaka teaches a housing (50) having a clip (30), wherein the clip comprises: a tool mating surface (32); a first projection (38) extending outwardly from the tool mating surface at a first end, and a second projection extending from a second end of the first projection. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the clip of Meurer et al. to include the second projection of Hayasaka for the purpose of providing a gripping engagement or to enclose the receiving space created by the tool mating surface and the first projection, thereby securing the hand held device to a surface.

With respect to claims 31, 32 and 35, the modified drill/driver of Sasaki et al. in view of Grieg discloses a drill/driver having a housing and a single, rigid holding means, detachably mounted to the housing, wherein the holding means is mounted to the housing via: a bore in the holding means, a first bore formed in the first side of the housing, and a second bore formed in the second side of the housing; wherein a fastener passes through the bore in the holding means and the first bore in the housing, in the first position, and wherein the fastener passes through the bore in the holding means and the second bore in the housing, in the second position. Sasaki et al. in view of Grieg does not disclose an indexing projection and an indexing projection recess.

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Hayasaka teaches a housing (50) and a detachable holding means (30), wherein an indexing projection 36) extending from the holding means (30) is received in an indexing projection recess (54) of the housing (50). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the housing and holding means of Meurer et al. to include the indexing projection and indexing projection recess of Hayasaka, for the purpose of properly positioning the holding means on the housing.

*Allowable Subject Matter*

9. Claims 9, 22, 23, 33 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter of claim 9: The art of record considered as a whole, alone or in combination, neither anticipates nor renders obvious a hand-held device comprising a housing and a detachably mounted clip, the clip having a tool mating surface; a first projection extending outwardly from the tool mating surface at a first end, and a second projection extending from a second end of the first projection, wherein the first projection has a concave, curved surface between the clip and the housing.

The following is a statement of reasons for the indication of allowable subject matter of claims 22, 23, 33 and 34: The art of record considered as a whole, alone or in combination, neither anticipates nor renders obvious a hand-held device comprising a housing and a detachably mounted holding means, wherein a pad is formed on the housing with a perimeter that corresponds to the general profile of the clip adjacent the housing, for the purpose of

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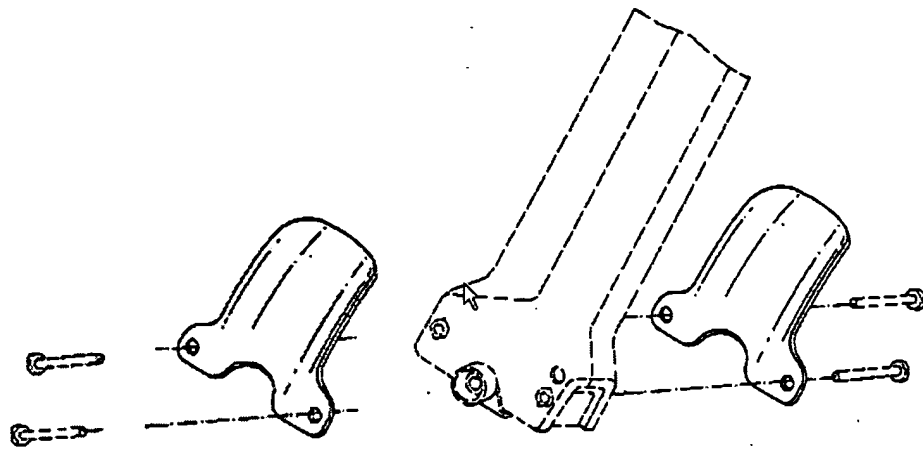
providing cushioning to the operator of the device when handling the device about the clip, as well as providing a visual orientation of the clip on the housing of the device.

***Response to Arguments***

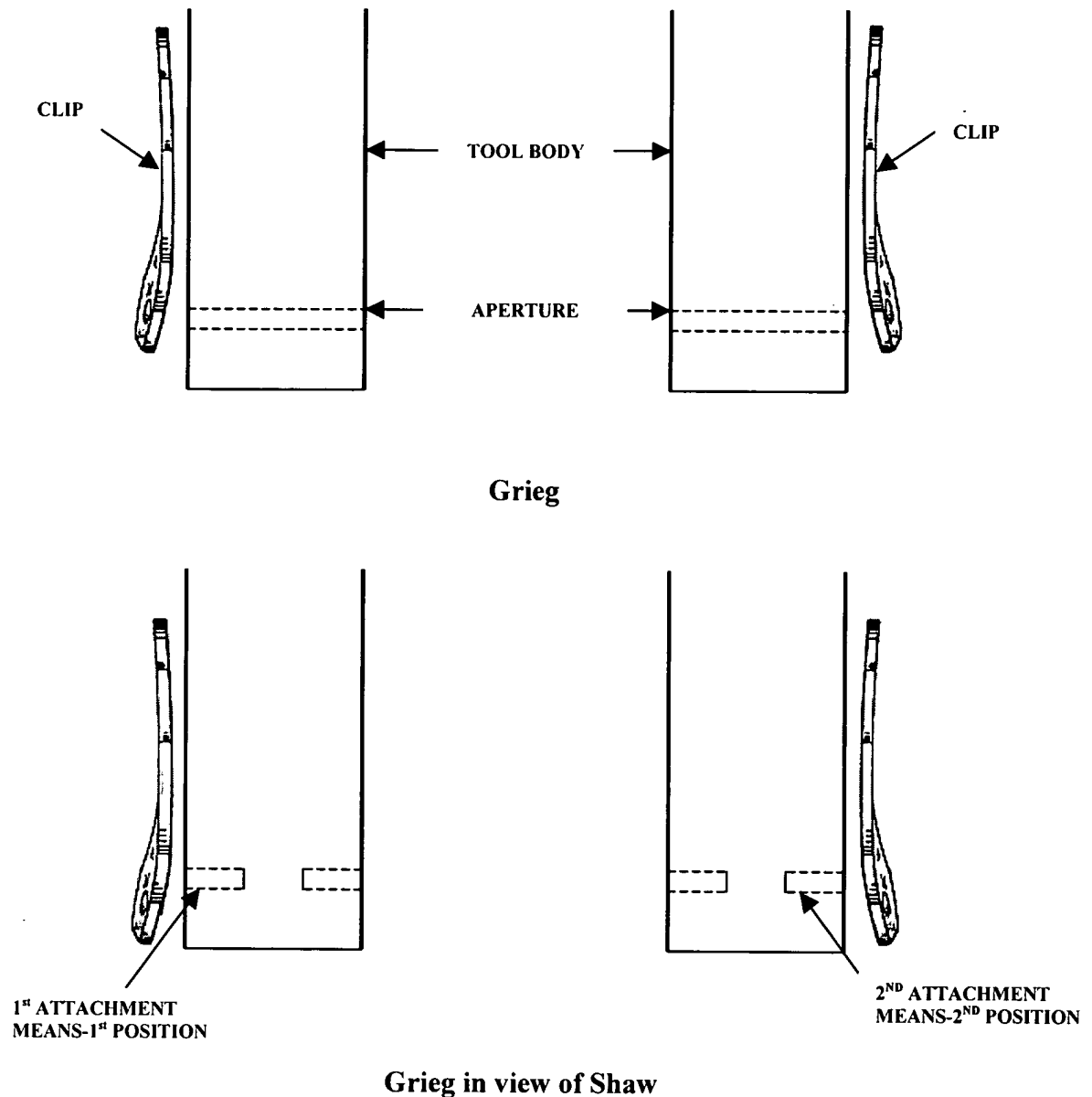
10. Applicant's arguments filed November 14, 2005 have been fully considered but they are not persuasive.

In response to Applicant's argument that Meurer fails to teach or suggest attaching a clip at multiple positions, Examiner disagrees in light of column 3 lines 34-43 which states that a first attachment means having a diameter of  $\frac{9}{16}$ th is used to attach the tool (100) at a position (16) on the clip, while a second attachment means having a diameter of  $\frac{7}{16}$ th is used to attach the tool (100) at a position (20) on the clip. Furthermore, column 2 lines 55-58 and column 3 lines 58-67 state that an operator can position the clip on either the left or right side of the tool for the purpose of accommodating a left-handed or right-handed operator.

Applicant has not found Greig to teach or suggest attaching a clip at a second position using a second attaching means without the use of a first attaching means of a first position. Examiner agrees, that Greigh does not specifically illustrate attaching the clip in a second position, however, the structure provided by Greigh is fully capable of attaching a clip at a second position (see illustration below), and it is found obvious to do so for the purpose of accommodating a left-handed or right-handed operator.



Additionally, Applicant has also argued that there is no suggestion or motivation to combine Greig with the teachings of Shaw. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, Greig disclosed a clip capable of being positioned on either side of a tool housing via through holes formed in the tool housing, thereby allowing the operator to use the same first and second attachment means in both positions. Examiner relied on Shaw for teaching that it is known in the art of power tools to attach a clip using either a through or non-through aperture, as the apertures are art recognized equivalents for the purpose of securing an attachment to a surface. Thus, one of ordinary skill in the art would have found it obvious to replace the through holes of Greig with the non-through holes of Shaw, thereby providing separate pairs of holes on either side of the housing to accommodate the clip.



Regarding Applicant's argument that the "indexing projection"(36) of Hayaska does not meet the requirements of an indexing projection as defined by Applicant's specification, Applicant appears to have misinterpreted the principle that claims are interpreted in light of the specification. Examiner is unsure as to what specific limitations Hayaska is argued to lack with



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respect to Applicant's claimed indexing projection, however, all limitations found to be Applicant's invention must be explicitly claimed. None the less, the indexing projection (36) of Hayaska as illustrated in figure 6 appears to be identical to the indexing projection (216) of Applicant's invention as illustrated in figure 2F.

Applicant's final argument questions Sasaki's disclosure of a clip means mounted on a "side" portion of the barrel of a tool. As Applicant has failed to define the "side" portion of the barrel with respect to any other element of the tool, one could reasonably define any surface of the barrel as a "side" portion. Although Examiner has found Meuer and Greig to teach mounting a clip to hand grip portion of the tool, these references were relied upon for their suggestion to detachably mount a clip means to a tool, as Sasaki is found to meet the limitations of a clip means mounted to a side portion of the barrel of a tool.

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to attachment for notice of references cited and recommended for consideration based on their disclosure of limitations of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gloria R. Weeks whose telephone number is (571) 272-4473. The examiner can normally be reached on 8:30 am - 7:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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grw  
January 18, 2006

Gloria R Weeks  
Examiner  
Art Unit 3721

  
**SCOTT A. SMITH**  
**PRIMARY EXAMINER**